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REMARKS

As a preliminary matter, it is noted that the initialed copy of the PTO-1449 form which the Examiner attached to the Office Action dated April 23, 2004 did not include the Examiner's initials for the prior art document entitled "Input/Output Operation Asynchronous Status Reporting Technique" listed in the "Other Art" section of the 1449 form. The Examiner did not provide any reason for not doing so, and it appears that the Examiner's omission may have been inadvertent. In order to clarify the record, it is respectfully requested that the Examiner send Applicants another copy of the PTO-1449 form with **all** references cited therein being initialed indicating that they have each been considered by the Examiner and made formally of record.

Applicants would like to thank the Examiner for the indication of allowable subject matter being recited by claims 15 and 16. Applicants respectfully submit that, as amended, claims 1-14 are patentable for the reasons that follow.

Claims 1-14 stand rejected under 35 U.S.C. § 112, first paragraph (written description) for reciting "digital." In order to expedite prosecution, "digital" has been deleted from the claims without prejudice or disclaimer. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 1, 11, 13 and 14 are independent and are submitted to be patentable over the cited prior art for at least the following reasons.

Claims 1 and 11 both recite in pertinent part "an error correcting section for performing error correction for data read from the optical disk and outputting an error

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correction result” so that status reports can be generated based on the error correction result. Because the status sampling section can selectively sample the status reports which are based on the error correction result, the optical controller of the present invention can make it possible to reduce the burden on a system controller with respect to the processing and analyzing of the status reports.

Turning to Imanaka et al., the alleged status sampling section 33-34 samples only an analog signal which is not based on an error correction result. It should be noted that error correction is usually executed for digital data. Nonetheless, Imanaka et al. is completely silent as to an error correcting section for performing error correction for data read from the optical disk and outputting an error correction result, let alone suggest generating status reports based on an error correction result.

Claims 13 and 14 both recite in pertinent part, “a status sampling section for selectively sampling the status reports so that the number of the status reports is decreased, and outputting only the selected status reports.” Because the number of the status reports can be decreased, the optical controller of the present invention can make it possible to reduce the burden on a system controller with respect to the processing and analyzing of the status reports.

Turning to Imanaka et al., the alleged status sampling section 33-34 samples only an analog signal. Because an analog signal defines continuous data, one analog signal does not contain a plurality of separate and distinct status reports each of which representing the operation state of the optical disk controller for a specific sector of the

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optical disk. Nonetheless, Imanaka et al. fails to disclose or suggest, *inter alia*, "a status sampling section for selectively sampling the status reports so that the number of the status reports is decreased, and outputting only the selected status reports".

As anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency (noting that "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), for the foregoing reasons, it is submitted that Imanaka et al. does not anticipate claims 1, 11, 13 and 14, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is non-obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. vs. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108(Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

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CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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